

IN THE UNITED STATES PATENT OFFICERECEIVED
CENTRAL FAX CENTER

Application Serial No. 10/020,881

Our Ref.: PT-1950001

APR 15 2004

CUSTOMER NO. 23607

Applicant: Dialysis Solutions Inc.

Agent: Neil H. Hughes, P.Eng.
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OFFICIAL

Title: STERILE LOW BICARBONATE-FREE DIALYSIS CONCENTRATE SOLUTIONS

Inventor: Sheldon Tobe

Examiner: Leslie R. Deak

Group Art Unit: 3762

Due Date: June 23, 2004

No. of Pages including this sheet: 5

DELIVERED TO FACSIMILE NO. (703) 872-9306

April 15, 2004

The Commissioner of Patents
UNITED STATES PATENT OFFICE
2011 Jefferson Davis Highway
Crystal Plaza 2, Room 1B03
Arlington, Virginia 22202 U.S.A.

Dear Examiner Deak:

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper:

1) Response to Examiner's Report dated March 23, 2004 Amendments and Remarks

is being facsimile transmitted to the United States Patent Office Facsimile No. (703) 872-9306
on the date shown below.

IVOR M. HUGHES

Agent for Applicant

Signature:

Neil H. Hughes, P.Eng. Reg. #33,636

Date: April 15, 2004

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**RESPONSE TO
EXAMINER'S REPORT DATED MARCH 23, 2004
AMENDMENTS & REMARKS**

April 15, 2004

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The Commissioner of Patents
UNITED STATES PATENT OFFICE
2011 South Clark Place
Crystal Plaza 2, Room 1B03
Arlington, Virginia, U.S.A. 22202

Dear Sir:

In response to the outstanding Official Action dated March 23, 2004 and due for response June 23, 2004 Applicant wishes to make the following submissions.

The Examiner in her action of March 23, 2004 has indicated that a restriction is required to one of the alleged inventions in I - IV. The Examiner had stated that the

- 2 -

inventions in the four groups are distinct from each other if it may be shown that they are separately usable. Authority for such restriction requirement is purported to have been derived from 35 U. S. C. 121.

However, 35 U. S. C. 121 states that if "two or more independent and distinct inventions are claimed in one application, the director may require the application to be restricted to one of the inventions. Clearly the requirement therefore is with reference to independent and distinct inventions which infers independent and distinct claims.

Respectfully the Examiner has organized the alleged species incorrectly because some of the claims in some of the groupings are not distinct from claim 1 or 11.

Claims 1 and 11 refer to a sterile dialysis concentrate composition and are presented in independent form. However, claims 2 and 3 depend from claim 1 and claims 12 and 13 dependent from claim 11. How can the Examiner's allegation that claims 2 and 3, and/or claim 12 and 13 are distinct and separate be possible when they clearly were drafted to depend from claim 1 or claim 11 respectively.

The Examiner has incorrectly stated that the kit of group 2 may simply relate to any concentrate solution. Clearly this can not be the case and is contrary to the claim set currently before the Examiner. Claim 2 or 12 depends on claim 1 or 11 and they may not be construed so broadly as to read on any concentrate solution. This is simply incorrect and respectively the meets and the bounds of the kit claims are not being interpreted properly by the Examiner. It is not the case that the kit claims of group 2 may relate to any concentrate solution but are in fact a kit for preparing the dialysis solution comprising the sterile dialysis concentrate composition of claim 1 or 11. This is a specific limitation in the claims. This same argument would be true for the methods of group III which the Examiner has alleged may be practiced with a variety of concentrate solutions which is simply not true. The method claims set out

- 3 -

in group III, that is 4, 7, 10, 14, 17, 19 and 20 all depend from claim 1 or 11 or claims depending from claim 1 or 11.

The same argument would be true with respect to the claims of group 4 namely claims 5, 6, 8, 9, 15, 16, and 18.

Therefore Applicant concludes that the Examiner's election requirement is not properly based nor has the Examiner properly classified the claims. Respectfully, Applicant would organize the claims in only one grouping in view of the fact that all claims depend from claim 1 or claim 11 or those claims depending therefrom

Therefore there should not be a requirement for an election restriction in Applicant's opinion.

Applicant therefore traverses the Examiner's restriction requirement and particularly traverses the grouping which the Examiner has alleged as being proper for her incorrect reasons since all the claims depending from claims dependent on claim 1 or 11 should be considered as proper grouping. Clearly they are not distinct from one another in the context of the fact that they are dependent claims. Should Applicant wish to draft independent claims related to kit claims then in fact respectfully they would not be distinctive. For example, claim 2 would read in independent form, "a kit for preparing a dialysis solution comprising a sterile dialysis concentrate composition and optionally instructions for its use". Such a claim would read on the prior art and it is the limitation of the kit claim of claim 2 to the dialysis concentrated of claim 1 in dependent claim format that makes it distinctive.

Applicant has clearly, in drafting the claim set, indicated which claims would be dependent on claim 1 or 11 or those dependent on those claims depending from claim 1 or 11. Applicant therefore requests that the Examiner reconsider her

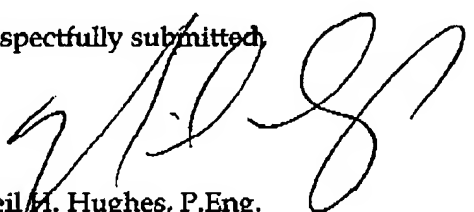
- 4 -

restriction requirement for the reasons set out above and which requirement is respectively traversed.

Applicant therefore elects with traverse the claims of group 1, namely claims 1 and 11, but further in addition asserts that all claims should be included in group 1 as being dependent upon the sterile dialysis concentrate composition of claim 1 or 11 and which claims are written in dependent form.

If the Examiner has any questions, she is respectfully requested to contact Applicants' Agent, Neil H. Hughes at (905) 771-6414 at her convenience.

Respectfully submitted,



Neil H. Hughes, P.Eng.
Registration No. 33,636
Agent for Applicant

NHH:jlh

c.c. Sheldon Tobe
Walter O'Rourke

Dialysis Solutions Inc. via facsimile
Dialysis Solutions Inc. via facsimile